

REMARKSIntroductory Comments

Claims 1-20 are pending in the present application. Claims 17 and 20 have been amended. Reconsideration of the application is respectfully requested.

Rejections of Claims 1-15 under 35 U.S.C. §102(b) - - Russell et al.

Claims 1-15 stand rejected under 35 U.S.C. §102(b) as being allegedly anticipated by U.S. Patent No. 6,050,433 to Russell et al. ("Russell"). This ground of rejection with respect to claims 1-15 is respectfully traversed.

The Office action alleges that Russell discloses each and every one of the limitations of claims 1-15. More specifically, it is alleged that Russell discloses in FIGS. 3-5, a closure comprising a cap 2 having an orifice 28, a channel 11 & 16 being adapted to receive a sliding member 6 therein; a flexible conduit 20, wherein the sliding member is operative to position the flexible conduit between an open position and a closed position, and at least a portion of the flexible conduit is located within the channel (a trench 16) in the closed position; the flexible conduit including a molded retention structure 23, the trench including a dam 17 operative to discontinue fluid communication with the beverage in the closed position; the trench running parallel to the channel and parallel to a range of movement to the sliding member; the sliding member being substantially radially recessed within the channel, and having at least one fin 15 received within at least one guide groove 11. It is further alleged that the closure of Russell is capable for use with a container. Applicants respectfully submit, however, that Russell fails to teach each and every one of the limitations of claims 1-15 and that the aforementioned characterizations of Russell are inaccurate.

Russell fails to teach a channel where at least a portion of the flexible conduit is received within the channel and where the channel receives the sliding member. The Office action impermissibly construes the channel 16 of Russell to include the contoured surfaces 11. This reading of Russell is neither consistent with the disclosure of Russell, nor within a plausible construction of Applicants' claims in light of the instant specification. Russell provides no basis for the conclusion that the contoured surfaces are a part of the channel 16. Instead, Russell makes clear that the surfaces 11 and the

channel 16 are separate components of the body portion 40 (see Col. 2, ll. 49-56). Moreover, the channel 16 of Russell does not receive at least a portion of the flexible conduit and the sliding member. Thus, claim 1 is distinguishable over Russell because claim 1 recites a channel that receives both at least a portion of the flexible conduit and the sliding member. Likewise, claims 2-15 are also patentably distinct from Russell for at least the same reasons articulated for claim 1. Incidentally, the construction the Examiner gives the claimed term "side wall" in claim 8, and thereby the construction of "channel" of claim 8, contradicts the construction the Examiner gives the term "channel" in claim 1.

In claim 8, the Examiner concludes that the contoured surfaces 11 of Russell form the "side walls," which requires that the "channel" be bounded substantially between the side walls. In other words, Examiner is construing the pair of raised ribs of Russell to form the side walls of the "channel," thereby resulting in the area between the ribs to be the channel 16. Thus, the construction of "channel" in claim 8 is inconsistent with the construction of "channel" in claim 1. Applicants respectfully submit that the only channel arguably taught by Russell that is bounded between the side walls is element 16 and therefore does not include the contoured surfaces 11. In sum, the instant grounds of rejection of claims 1 and 8 in view of Russell cannot be squared with a single construction of "channel."

Numerous other limitations found within claims 2-15 are not disclosed by Russell. For example, claim 4 requires the flexible conduit include molded retention features thereon to inhibit the flexible conduit from being pulled through the orifice. Further, claim 7 requires the sliding member be substantially radially recessed within the channel, and claim 8 requires that the sliding member include at least one fin received within at least one guide groove formed within a side wall of the channel. Still further, claim 12 requires that the container include a lenticular image, claim 13 requires that the container include concentric gripping rings, and claim 15 requires the container include a holographic image. None of these limitations are disclosed by Russell and any indication in the Office action to the contrary is without merit.

In light of the foregoing, it is respectfully submitted that independent claim 1 is patentably distinct from the disclosure of Russell and is therefore in condition for

allowance. Likewise, claims 2-15 that depend from claim 1 are in condition for allowance for at least the same reasons stated for claim 1. Reconsideration and withdrawal of the 35 U.S.C. §102(b) rejections of record for claims 1-15 in light of Russell are respectfully requested.

Rejections of Claims 17-20 under 35 U.S.C. §103(a) - - Saklad & Williams

Claims 17-20 stand rejected under 35 U.S.C. §103(a) as being allegedly obvious over U.S. Patent No. 5,150,815 to Saklad ("Saklad") in view of U.S. Patent No. 6,718,664 to Williams ("Williams"). This ground of rejection with respect to claims 17-20 has been overcome by the amendment to claim 17.

To render obvious claims 17-20, Saklad and Williams must: (1) provide some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference; (2) provide a reasonable expectation of success; and (3) teach or suggest all the claim limitations. M.P.E.P. § 2143. The Office action fails to meet all of these requirements with respect to the allegation that Applicants' claims 17-20 are obvious in light of Saklad combined with Williams.

Claim 17 includes the limitation that at least a portion of the flexible conduit is located within the channel in the closed position. Neither Saklad nor Williams teach such a limitation. Moreover, neither reference provides the requisite motivation to combine the disclosures to bring about an embodiment reading on Applicants' claims. It should be noted that Applicants' discussion regarding lenticular images in [0026] should not be construed as an admission or acquiescence that lenticular images are known to be associated with beverage containers, but instead was simply a statement that the process for forming lenticular images was known to those of skill in the lenticular art and therefore Applicants need not teach how lenticular images are formed.

Neither Saklad nor Williams discloses a cap having an arched channel being adapted to receive a sliding member therein, where the sliding member is operative to position the flexible conduit to protrude from an outer surface in the open position and recess the flexible conduit within an outer circumferential surface in the closed position. This and other limitations found in claims 18-20 are absent from the disclosures of the

cited patents, thereby rendering the instant grounds of rejection of claims 17-20 untenable.

In light of the foregoing, it is respectfully submitted that independent claim 17 is patentably distinct from the disclosures of Saklad and Williams, and is therefore in condition for allowance. Likewise, claims 18-20 that depend from claim 17 are in condition for allowance for at least the same reasons stated for claim 17. Reconsideration and withdrawal of the 35 U.S.C. §103(a) rejections of record for claims 17-20 in light of Saklad and Williams are respectfully requested.

Rejections of Claims 12, 15, 17-20 under 35 U.S.C. §103(a) - - Russell, Saklad & Williams

Claims 12, 15, and 17-20 stand rejected under 35 U.S.C. §103(a) as being allegedly obvious over U.S. Patent No. 6,050,433 to Russell et al. ("Russell") in view of U.S. Patent No. 5,150,815 to Saklad ("Saklad") and in further view of U.S. Patent No. 6,718,664 to Williams ("Williams"). This ground of rejection with respect to claims 17-20 has been overcome by the amendment to claim 17, and is traversed with respect to claims 12 and 15.

To render obvious claims 12, 15, and 17-20, Russell, Saklad, and Williams must: (1) provide some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference; (2) provide a reasonable expectation of success; and (3) teach or suggest all the claim limitations. M.P.E.P. § 2143. The Office action fails to meet all of these requirements with respect to the allegation that Applicants' claims 12, 15, and 17-20 are obvious in light of Russell combined with Saklad combined with Williams.

None of the three cited references teaches a channel where at least a portion of the flexible conduit is received within the channel and where the channel receives the sliding member. Therefore, claims 12, 15, and 20 cannot be properly rejected under 35 U.S.C. §103(a) because all the claim limitations are not taught or suggested by the cited references. M.P.E.P. § 2143. As discussed previously, the Office action impermissibly construes the channel 16 of Russell to include the contoured surfaces 11 to allegedly meet the limitations of claims 1 and claims 20. Russell provides no basis for the conclusion

that the contoured surfaces are a part of the channel 16. Instead, Russell makes clear that the surfaces 11 and the channel 16 are separate components of the body portion 40 (see Col. 2, IL 49-56). Thus, claims 12, 15, and 20 are distinguishable over each of the cited references because the claims require a channel that receives both at least a portion of the flexible conduit and the sliding member. Without references teaching all of the limitations, there can never be a reasonable expectation of success to modify the references based upon some suggestion or motivation to amend the references.

The Office action also fails to provide any rationale, other than impermissibly using Applicants' own claims, for why one skilled in the art would make the alleged combination. Applicants respectfully submit that the Office action has done nothing more than parse the invention into individual component parts and found prior art references teaching these individual parts. The Federal Circuit recently discussed the obviousness inquiry and admonished breaking the invention into component parts, in lieu of viewing the invention as a whole, in *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332 (Fed. Cir. 2005). The following is a passage from this case which is instructive and supports Applicants' position that the instant grounds of rejection for obviousness be withdrawn:

As this court outlined in *Rutz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004), in making the assessment of differences between the prior art and the claimed subject matter, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. *Envtl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements"). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. *Rutz*, 357 F.3d at 1275. Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. *Id.* This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result—often the essence of invention. *Id.*

Contrary to this reasoning, section 103 requires assessment of the invention as a whole. *Id.* This "as a whole" assessment of the invention requires a showing that an artisan of ordinary skill in the art at the time of

invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in the claimed manner. *Id.*

*Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005). Thus, Applicants' invention, as a whole, is patentably distinct from the references cited.

It should also be noted that Applicants' discussion regarding lenticular images in [0026] should not be construed as an admission or acquiescence that lenticular images are known to be included with beverage containers, but instead was simply a statement that the process for forming lenticular images was known to those of skill in the lenticular art and therefore Applicants need not teach how lenticular images are formed.

In light of the foregoing, it is respectfully submitted that claims 12, 15, and 17-20 are patentably distinct from the disclosures of Russell, Saklad, and Williams, and are therefore in condition for allowance. Reconsideration and withdrawal of the 35 U.S.C. §103(a) rejections of record for claims 12, 15, and 17-20 in light of Russell, Saklad, and Williams are respectfully requested.

Rejection of Claim 13 under 35 U.S.C. §103(a) - Russell, Saklad, & Otake

Claim 13 stands rejected under 35 U.S.C. §103(a) as being allegedly obvious in light of U.S. Patent No. 6,050,433 to Russell et al. ("Russell") in view of U.S. Patent No. 5,150,815 to Saklad ("Saklad"), and in further view of U.S. Patent No. D431,150 to Otake ("Otake"). This ground of rejection with respect to claim 13 is respectfully traversed.

As previously discussed, the Office action alleges that Saklad and Russell disclose each and every one of the limitations of claim 1. However, Saklad and Russell each fail to disclose a channel that receives at least a portion of the flexible conduit and the sliding member. Therefore, it is irrelevant whether Otake discloses the limitation of claim 13 of concentric gripping rings because the other cited references fail to teach the remaining limitations. In sum, the alleged combination of Saklad, Russell, and Otake fail to teach each and every one of the limitations of claim 13 and, therefore, claim 13 is in condition

for allowance. Reconsideration and withdrawal of the 35 U.S.C. §103(a) rejection of record for claim 13 are respectfully requested.

Rejection of Claim 16 under 35 U.S.C. §103(a) - - Russell, Saklad, & Goto

Claim 16 stands rejected under 35 U.S.C. §103(a) as being allegedly obvious in light of U.S. Patent No. 6,050,433 to Russell et al. ("Russell") in view of U.S. Patent No. 5,150,815 to Saklad ("Saklad"), and in further view of or U.S. Patent No. D363,414 to Goto et al. ("Goto"). This ground of rejection with respect to claim 16 is respectfully traversed.

As previously discussed, the Office action alleges that Saklad and Russell disclose each and every one of the limitations of claim 1. However, Saklad and Russell each fail to disclose a channel that receives at least a portion of the flexible conduit and the sliding member. Therefore, it is irrelevant whether Goto discloses the limitation of circumferentially arranged gripping aids because the other cited references fail to teach the remaining limitations of claim 16. In sum, the alleged combination of Saklad, Russell, and Goto fail to teach each and every one of the limitations of claim 16 and, therefore, claim 16 is in condition for allowance. Reconsideration and withdrawal of the 35 U.S.C. §103(a) rejection of record for claim 16 are respectfully requested.

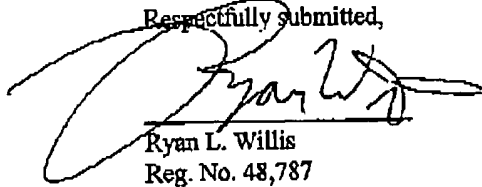
Conclusion

In light of the foregoing, it is respectfully submitted that claims 1-20, now pending, are patentably distinct from the references cited and are in condition for allowance. Reconsideration and withdrawal of the rejections of record are respectfully requested.

The Commissioner for Patents is hereby authorized to charge any additional fees that may be required by this paper, or to credit any overpayment to Deposit Account 50-3072.

In the event that the Examiner wishes to discuss any aspect of this response,  
please contact the undersigned at the telephone number provided below.

Respectfully submitted,



Ryan L. Willis  
Reg. No. 48,787

30074  
Taft, Stettinius & Hollister LLP  
425 Walnut Street; Suite 1800  
Cincinnati, OH 45202-3957  
513-357-9663  
willis@taftlaw.com